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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

160245-87US

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name _____

Application Number

10/709,360

Filed

04/29/2004

First Named Inventor

Dori Laskin

Art Unit

3695

Examiner

Irene S. Kang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/95)

☒ attorney or agent of record.

Registration number 35039

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Clark Jablon

Signature

Clark A. Jablon

Typed or printed name

215-965-1293

Telephone number

December 1, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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1. There is a clear error in the Examiner's outstanding rejection of independent claims 1, 9, 17, 22, 25, 32, 39 and 43 because there is no proper motivation to modify Morano's process to include a "QDI calculation engine...to automatically determine the personal QDI" (claims 1, 25); or to "automatically [determine] the personal QDI...using a QDI calculation engine" (claims 9, 17, 32, 39); or to "automatically [perform] a personal QDI calculation" (claims 22 and 43).

The reasons for this clear error are given in Applicants' "Amendment Under 37 C.F.R. 1.111" filed May 28, 2008, hereafter, referred to as "the 5/28/08 Response." See the arguments on pages 3-8 of the 5/28/08 Response.¹ A brief summary of the arguments is repeated herein (underlining added for emphasis).

Applicants' disclosure provides a detailed explanation of how to automatically perform personal QDI calculations for individual investors using apparatus and databases that contain all of the information necessary for such calculations. The disclosure provides 20 sheets of schematic block diagrams, flowcharts, spreadsheets and user interface display screens, accompanied by 27 pages of explanation. In contrast, PWC provides no explanation whatsoever of any systems, methods or databases that are required to perform such calculations, and even states that doing so "may prove challenging." Furthermore, in view of the fact that there is no requirement for mutual funds to calculate what the personal QDI should be for a specific investor, the modification to Moreno is inherently flawed because there is no design need or market pressure to even solve the problem of providing a personal QDI feature in Moreno. (pages 6-7 of the 5/28/08 Response)

¹ The published guidelines for Pre-Appeal Briefs explicitly encourage Applicants to refer to arguments already of record rather than repeating them in the request. See part 4 of the guidelines, repeated below (underlining added for emphasis)

4. Content of Remarks or Arguments:

The request should specify-

- clear errors in the examiner's rejections; or
- the examiner's omissions of one or more essential elements needed for a prima facie rejection.

For example, the request should concisely point out that a limitation is not met by a reference or the examiner failed to show proper motivation for making a modification in an obviousness rejection (35 U.S.C. 103). Applicants are encouraged to refer to arguments already of record rather than repeating them in the request. This may be done by simply referring to a prior submission by paper number and the relevant portions thereof (e.g., see paper number 3 at pages 4 to 6). However, references such as "see the arguments of record" or "see paper number X" are not helpful and will just obfuscate the real issues for review.

2. The Examiner's outstanding rejection of independent claims 1, 9, 17, 22, 25, 32, 39 and 43 has an omission of one or more essential elements needed for a prima facie rejection, namely, a "QDI calculation engine...to automatically determine the personal QDI" (claims 1, 25); a step of "automatically determining the personal QDI...using a QDI calculation engine" (claims 9, 17, 32, 39); or a step of "automatically performing a personal QDI calculation" (claims 22 and 43).

As discussed in the 5/28/08 Response, PWC provides no explanation whatsoever of any systems, methods or databases that are required to perform QDI calculations, and even states that doing so "may prove challenging." Thus, even if Morano is modified as suggested by the Examiner to incorporate the disclosure in PWC, the resultant modified version of Morano would still lack a "QDI calculation engine...to automatically determine the personal QDI" (claims 1, 25); a step of "automatically determining the personal QDI...using a QDI calculation engine" (claims 9, 17, 32, 39); or a step of "automatically performing a personal QDI calculation" (claims 22 and 43). Stated simply, since PWC has no disclosure of these features, the modified version of Morano would likewise lack these features.

3. There is also clear error in the Examiner's outstanding rejection of independent claims 22 and 43 because there is no proper motivation to modify Morano's process to include the feature in step (c) of "automatically comparing in the computer the personal QDI and the QDI on the Form 1099-DIV".²

As discussed on pages 7-8 of the 5/28/08 Response, the Examiner provides no rationale for generating personal QDI statements for only those investors who need one. This concept was gleaned entirely from Applicants' specification. The Examiner has not highlighted any knowledge which was within the level of an artisan for justifying a further modification to Morano to provide this feature.

4. The Examiner's outstanding rejection of independent claims 22 and 43 has an omission of one or more additional essential elements needed for a prima facie rejection, namely, the feature in step (c) of "automatically comparing in the computer the personal QDI and the QDI on the Form 1099-DIV".

As discussed on pages 7-8 of the 5/28/08 Response, even if personal QDI statements were added to Morano in view of PWC, the resultant modified version of Morano would lack

² Amended claim 22 presented in the Supplemental Amendment filed August 6, 2008 inadvertently deleted the "--" (dash) in "1099-DIV." The dash appears in the original version of claim 22. Applicants will correct this obvious error in an amendment prior to allowance.

this feature. The modified version of Morano would generate personal QDI statements for all investors, even if the personal QDI is the same amount as the QDI on the Form 1099-DIV. That is, the invention concept of generating personal QDI statements for only those investors who need one is lacking in both of the applied references.

5. Examiner's Final Rejection

On pages 2-16 of the Final Rejection, the Examiner repeats verbatim the same grounds of rejection given in the previous rejection. Since these grounds were addressed in the 5/28/08 response, no further comments are provided herein regarding such grounds.

On pages 17-18 of the Final Rejection, the Examiner provides a new "Response to Arguments" section. However, this section consists almost entirely of non-responsive statements that recite well-established and undisputed case law that is not relevant to the outstanding rejection or to Applicants' rebuttal thereof. That is, the Examiner provided no explanation of why the mere statements in PWC about JGTRRA, which does nothing more than summarize the provisions of JGTRRA referred to in the background section of Applicants' specification (see, paragraphs [0001] through [0006]), rises to the level of a sufficient disclosure to meet the claimed "QDI calculation engine...to automatically determine the personal QDI" (claims 1, 25); a step of "automatically determining the personal QDI...using a QDI calculation engine" (claims 9, 17, 32, 39); or a step of "automatically performing a personal QDI calculation" (claims 22 and 43) and to motivate an artisan to add these features to Morano. Applicants reiterate again that these features are supported by 20 sheets of schematic block diagrams, flowcharts, spreadsheets and user interface display screens, accompanied by 27 pages of explanation, compared to PWC's complete lack of any explanation whatsoever of any systems, methods or databases that are required to perform such calculations, and the statement in PWC that doing so "may prove challenging."

Nor does the Examiner explain why it is obvious to modify Morano in view of the fact that there is no requirement for mutual funds to calculate what the personal QDI should be for a specific investor, and thus there is no design need or market pressure to even solve the problem of providing a personal QDI feature in Morano.

Turning to the Examiner's response, the Examiner first asserts that hindsight reasoning is permitted to reconstruct the claimed invention if "it takes into account only knowledge which was within the level of ordinary skill in the art...and does not include knowledge gleaned only

from the applicant's disclosure." This is well-established case law, but fails to rebut either of Applicants' arguments for patentability.

Second, the Examiner alleges that Applicants attacked the references individually when the rejection was based on the combination of the references. This is well-established case law, but also fails to rebut either of Applicants' arguments for patentability. If feature X is absent from reference A and the rejection relies on modifying reference A to incorporate feature X from reference B, it is entirely appropriate to rebut such an argument by pointing out that reference B does not actually disclose feature X (as discussed above, PWC does not actually have any technical disclosure of the claimed feature), as well as arguing that there is no suggestion or other reason to incorporate feature X into reference A.

Third, the Examiner responds to Applicants' argument that there is no suggestion to combine the references by asserting that although PWC states that doing personal QDI calculations "may prove challenging", the concept of calculating and reporting personal QDI is disclosed on at least pages 6 and 7 of PWC. In response, Applicants are not claiming the concept of calculating and reporting personal QDI. Applicants are claiming actually doing it ("QDI calculation engine...to automatically determine the personal QDI" (claims 1, 25); a step of "automatically determining the personal QDI...using a QDI calculation engine" (claims 9, 17, 32, 39); or a step of "automatically performing a personal QDI calculation" (claims 22 and 43)).

Fourth, regarding step (c) of claims 22 and 43, the Examiner responds to Applicants' arguments by asserting again that hindsight reasoning may rely upon knowledge which was within the level of an artisan. This is well-established case law, but also fails to rebut either of Applicants' arguments for patentability of these claims. The Examiner has not provided any reasoning of what that knowledge is, and why it would be applicable to the claimed invention. Mutual funds report all sorts of forms to their investors without any regard for whether the investor may need the forms or not. The additional claimed feature addresses one specific form and provides a recipient filter for the form.

6. KSR vs. Teleflex

Nor do any of the USPTO guidelines regarding obviousness set forth in *KSR v. Teleflex*, 127 S. Ct. 1727 (2007) provide sufficient grounds for the outstanding rejection. MPEP 2141 provides "Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103."

Section III of MPEP 2141 sets forth the following seven exemplary rationales that may support a conclusion of obviousness:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

None of these rationales exist in the present case and none have even been properly articulated by the Examiner.

7. There is a clear error in the Examiner's outstanding rejection of the dependent claims.

The dependent claims are believed to be allowable because they depend upon respective allowable independent claims, and because they recite additional patentable steps.

8. None of the arguments above depend upon interpretations of prior art teachings or claim scope issues. For at least the reasons set forth above, all of the outstanding prior art rejections should be withdrawn.